

to § 1.530, and the order will not set a time period within which to file such a statement;

(2) Reexamination of any claim of the patent may be conducted on the basis of any item of information as set forth in § 1.605, and is not limited to patents and printed publications or to subject matter that has been added or deleted during the reexamination proceeding, notwithstanding § 1.552(a);

(3) Issues in addition to those raised by patents and printed publications, and by subject matter added or deleted during a reexamination proceeding, may be considered and resolved, notwithstanding § 1.552(c); and

(4) Information material to patentability will be defined by § 1.56(b), notwithstanding § 1.555(b).

Subpart F—Adjustment and Extension of Patent Term

AUTHORITY: 35 U.S.C. 2(b)(2), 154, and 156.

SOURCE: 52 FR 9394, Mar. 24, 1987, unless otherwise noted.

ADJUSTMENT OF PATENT TERM DUE TO EXAMINATION DELAY

§ 1.701 Extension of patent term due to examination delay under the Uruguay Round Agreements Act (original applications, other than designs, filed on or after June 8, 1995, and before May 29, 2000).

(a) A patent, other than for designs, issued on an application filed on or after June 8, 1995, is entitled to extension of the patent term if the issuance of the patent was delayed due to:

(1) Interference or derivation proceedings under 35 U.S.C. 135(a); and/or

(2) The application being placed under a secrecy order under 35 U.S.C. 181; and/or

(3) Appellate review by the Patent Trial and Appeal Board or by a Federal court under 35 U.S.C. 141 or 145, if the patent was issued pursuant to a decision in the review reversing an adverse determination of patentability and if the patent is not subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct from

that under appellate review. If an application is remanded by a panel of the Patent Trial and Appeal Board and the remand is the last action by a panel of the Patent Trial and Appeal Board prior to the mailing of a notice of allowance under 35 U.S.C. 151 in the application, the remand shall be considered a decision in the review reversing an adverse determination of patentability as that phrase is used in 35 U.S.C. 154(b)(2) as amended by section 532(a) of the Uruguay Round Agreements Act, Public Law 103-465, 108 Stat. 4809, 4983-85 (1994), and a final decision in favor of the applicant under paragraph (c)(3) of this section. A remand by a panel of the Patent Trial and Appeal Board shall not be considered a decision in the review reversing an adverse determination of patentability as provided in this paragraph if there is filed a request for continued examination under 35 U.S.C. 132(b) that was not first preceded by the mailing, after such remand, of at least one of an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151.

(b) The term of a patent entitled to extension under paragraph (a) of this section shall be extended for the sum of the periods of delay calculated under paragraphs (c)(1), (c)(2), (c)(3) and (d) of this section, to the extent that these periods are not overlapping, up to a maximum of five years. The extension will run from the expiration date of the patent.

(c)(1) The period of delay under paragraph (a)(1) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) With respect to each interference or derivation proceeding in which the application was involved, the number of days, if any, in the period beginning on the date the interference or derivation proceeding was instituted to involve the application in the interference or derivation proceeding and ending on the date that the interference or derivation proceeding was terminated with respect to the application; and

(ii) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Patent and Trademark Office